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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,056	10/10/2001	Michihiro Izumi	35.C15861	5038

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FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

ENG, GEORGE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/973,056	<b>Applicant(s)</b> IZUMI ET AL.	
	<b>Examiner</b> George Eng	<b>Art Unit</b> 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/16/2004 has been entered.

### ***Response to Amendment***

2. This Office action is in response to the amendment filed 6/14/2004.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 5-8, 12-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubara et al. (US PAT. 6,545,768 hereinafter Matsubara) in view of Idehara (US PAT. 6,438,605).

Regarding claim 1, Matsubara discloses a communication terminal equipment as shown in figure 13 including means for connection to a public communication line, a scanner (32, figure 14) for reading an image, means (25, figure 1) for converting the image read by the scanner to have a predetermined format (col. 7 lines 22-31), means for executing a sending process (36, figure 14) to send to a server connected to the public communication line in a case when the communication terminal equipment sends the converted image as an electronic mail to the Internet comprising means for registering a facsimile number of a destination to which the image should be sent for an abbreviation number, i.e., a key number 01, and for registering an electronic mail address of a destination for the same abbreviation number, means for executing the facsimile sending of the read image to the registered facsimile number when the facsimile communication is judged, and means for executing the electronic mail sending of the read image to the registered electronic mail address when the electronic mail communication is judged (col. 12 line 34 through col. 15 line 34). Matsubara differs from the claimed invention in not specifically teaching a key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and a key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for

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executing electronic mail sending. However, Idehara teaches communication equipment including operating mode selection buttons, i.e., a key representing the facsimile sending (31a, figure 2) and a key representing the electronic mail (31e, figure 2), on an operation panel for selecting between e-mail mode and a facsimile mode col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19) in order to make user friendly. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Matsubara in having the key representing the facsimile sending is depressed pursuant to depression of said abbreviation dial key for executing facsimile sending and the key representing the electronic mail sending is depressed pursuant to depression of said abbreviation dial key for executing electronic mail sending, as per teaching of Idehara, it makes user friendly for selecting between the facsimile mode and the e-mail mode.

Regarding claim 5, Idehara teaches means for registering input data as the electronic mail address in a case where said key representing the electronic mail sending is depressed pursuant to input of the electronic address and means for registering input data as the facsimile number in a case where said key representing the facsimile sending is depressed pursuant to input of the facsimile data in the registering process for the abbreviation number (col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19).

Regarding claim 6, Idehara teaches means for registering input data as the electronic mail address in a case where a specific symbol, i.e., @, used in the electronic mail address is included in the input data in the registering process for the abbreviation number (col. 4 lines 3-32 and col. 10 lines 17-19).

Regarding claim 7, Idehara discloses the communication equipment including a first CPU (11, figure 1) for detecting that said key representing the electronic mail sending is depressed, means for notifying a second CPU (18, figure 1) that the first CPU executed the detection, means for forming electronic mail data when the second CPU receives the notification and means for executing the data sending process from said second CPU to the public communication line (col. 3 lines 49-57 and col. 5 lines 9-48).

Regarding claim 8, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 12, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claim 19, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 20, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 7.

5. Claims 2, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubara et al. (US PAT. 6,545,768 hereinafter Matsubara) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Ishibashi et al. (EP 812100 A2 hereinafter Ishibashi).

Regarding claim 2, the combination of Matsubara and Idehara differs from the claimed invention in not specifically teaching means for notifying the destination by using the facsimile number registered for the abbreviation number of sending a notification in electronic mail format within a predetermined time before or after the sending of the electronic mail in a case in which the electronic mail is sent to the electronic mail address. However, Ishibashi teaches a communication terminal apparatus capable of informing a receiving side of with a transmission of an electronic mail in case of sending the electronic mail to the electronic mail address (page 2 lines 42-59 and page 4 line 40 through page 6 line 29) in order to quickly notify the receiving side that electronic mail has been transmitted. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Matsubara and Idehara in notifying the destination by using the facsimile number registered for the abbreviation number of sending a notification in electronic mail format within a predetermined time before or after the sending of the electronic mail in a case in which the electronic mail is sent to the electronic mail address, as per teaching of Ishibashi, in order to quickly notify the receiving side that electronic mail has been transmitted.

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 2.

6. Claims 3-4, 10-11 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsubara et al. (US PAT. 6,545,768 hereinafter Matsubara) in view of Idehara (US PAT. 6,438,605) as applied in claims above, and further in view of Yazaki (JP 10126600 A).

Regarding claim 3, Matsubara discloses the communication terminal equipment for executing the facsimile sending of the read image to the registered facsimile number by using a first communication channel (4, figure 1) and executes the electronic mail sending of the read image to the registered electronic mail address by using a second communication channel (3, figure 1) by depression of the key corresponding to the abbreviation number (col. 12 line 34 through col. 15 line 34) and Idehara teaches to depress said key representing the facsimile sending and said key representing the electronic mail sending for executing facsimile sending and electronic mail sending col. 4 line 3 through col. 5 line 4 and col. 10 lines 17-19). The combination of Matsubara and Idehara differs from the claimed invention in not specifically teaching to simultaneously executing plural communications. However, Yazaki teaches a communication terminal equipment to allow an adapted data transmission means to send data by registering a logic address of a transmission destination and a data transmission means in cross reference so that the data transmission means corresponding to the selected logic address sends data to each destination when an operation section select the logic address of the destination, thereby data can be sent automatically to each physical address (abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to



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modify the combination of Matsubara and Idehara in simultaneously executing plural communications, as per teaching of Yazaki, thereby data can be sent automatically to each physical address.

Regarding claim 4, although neither the combination of Matsubara and Idehara nor Yazaki specifically discloses a key representing simultaneously sending of the facsimile and the electronic mail, it is well known in the art of combining said key representing the facsimile sending and said key representing the electronic mail sending as one key for simplifying operation structure so that plural communications, i.e., facsimile sending and electronic mail sending, can be simultaneous performed when a key representing simultaneously sending of the facsimile and the electronic mail is depressed. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Matsubara, Idehara and Yazaki in having the key representing simultaneously sending of the facsimile and the electronic mail in order to simplify operation structure.

Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 11, the limitations of the claim are rejected as the same reasons set forth in claim 4.

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 3.

Regarding claim 18, the limitations of the claim are rejected as the same reasons set forth in claim 4.

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

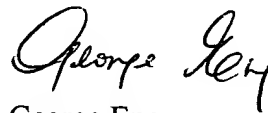
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Okada (US PAT. 6,101,244) discloses a communication terminal device having an electronic mail address and facsimile number corresponding to a recipient being both stored in a memory (abstract). Hatakeyama (JP 2000059531A) discloses a facsimile machine with improved one-touch dial function (abstract).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is (571) 272-7495. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "George Eng".

George Eng  
Primary Examiner  
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